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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,587	09/21/2001	Kirk W. Skeba	42390P11693	5439

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EXAMINER

ENG, GEORGE

ART UNIT

PAPER NUMBER

2643

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#2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,587

Applicant(s)

SKEBA, KIRK W.

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-10, 16-22 and 30-36 of copending Application No. 10/028,467. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations, i.e., the receiving step, the comparing step, and the certifying step are found in copending Application No. 10/028,467 with obvious wording variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps of receiving a third identification, comparing the third identification with a fourth identification stored at a second analog front end, and certifying a second software-defined radio for operation if the third identification matches the fourth identification must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 7, 16, 19 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, the specification fails to clearly teach or disclose the method steps of including a third identification at the computer system from the server via the transmission medium, comparing the third identification with a fourth identification stored at a second analog front end coupled to the computer system, and certifying a second software-defined radio for operation if the third identification matches the fourth identification as shown in claim 1, as well as the similar limitation in claims 16, 19 and 23. Instead, the specification merely teaches to compare the identification within a received protocol, i.e., the first identification, with the identification stored in non-volatile memory, i.e., the second identification, and certify the software radio for operation if the first and the second identifications are matched (figure 4 and page 17). Thus, the claim containing the limitations, i.e., third identification, fourth identification, second analog front end, and second software-defined radio, are not described the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 7-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over England et al. (US PAT. 5,511,069 hereinafter England) in view of Liao et al. (US PAT. 6,292,833 hereinafter Liao).

Regarding claim 1, England discloses a computer system including a baseband unit (30, figure 1) and a first analog front end (50, figure 1) coupled to the baseband unit and the computer system for transmitting and receiving signals via a wireless transmission medium (col. 2 lines 53-63 and col. 3 line 51 through col. 4 line 20). England differs from the claimed invention in not specifically teaching to certify a first software-defined radio for operation by the steps of receiving a first identification at the computer system from a server, comparing the first identification with a second identification stored at the first analog front end and certifying the first software-defined radio for operation if the first identification matches the second identification. However, Liao teaches a technique for ensuring secure access to local service of a communication device of a wireless communication system comprising the steps of receiving a message including an identifier, i.e., a first identifier, from a network, i.e., a server, comparing the received first identifier with authorized service identities, i.e., a second identifier, stored

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within the communication device, i.e., at a first analog front end, and certifying a first software-defined radio for operation if the first identifier matches the second identifier (figure 3 and col. 6 line 36 through col. 7 line 54). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify England in having the operating steps of comparing the first identification received from a server with a second identification stored at the first analog front end and certifying the first software-defined radio for operation if the first identification matches the second identification, as per teaching of Liao, in order to ensure secure access to local service of the communication device.

Regarding claim 2, Liao teaches to disable the first software defined radio when the first identifier does not match the second identifier (col. 7 lines 37-43).

Regarding claim 3, Liao teaches to store the first identifier in a memory device (776, figure 7B) within the communication device prior to compare the first identifier with the second identifier (col. 14 lines 23-25).

Regarding claim 4, Liao teaches to downloading a protocol corresponding with the first software-defined radio (col. 14 line 29 through col. 15 line 6).

Regarding claim 7, Liao teaches the communication device and the network gateway capable of using a variety different communication protocols via different networks (col. 4 lines 43-57) so that one of the ordinary skill in the art would recognize Liao in capable of receiving a third identification at the computer system from the server via the transmission medium, comparing the third identification with a fourth identification stored at a second analog front end coupled to the computer system, and certifying a second software-defined radio for operation if

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the third identification matches the fourth identification, in order to operate at software-defined radio.

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 9, England discloses an input/output bus (12, figure 1) coupled to the baseband unit (30, figure 1) and a network controller (44, figure 1) coupled to the I/O bus (col. 3 lines 6-19).

Regarding claim 10, Liao teaches to receive the first identifier from the network, i.e., a server computer, via a transmission medium coupled to the network controller (col. 6 lines 36-63 and col. 8 lines 3-13).

Regarding claim 11, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claims 12-13, Liao discloses the communication device comprising an I/O interface (752, figure 7B) coupled to the I/O bus, a DSP (756, figure 7B)) coupled to the I/O interface and a second bus coupled to the DSP, wherein the communication device further comprises a volatile memory (766, figure 7B) and a non-volatile memory (764, figure 7B) coupled to the DSP.

Regarding claim 14, England disclose the analog front end (418, figure 4) comprising analog-digital/digital-analog conversion logic coupled to the second bus (232, figure 3), modulation logic (302 and 304, figure 2) coupled to the AD/DA conversion logic, a transceiver (316, figure 2) coupled to the modulation logic and an antenna (318, figure 2) coupled to the transceiver (col. 4 lines 3 lines 55-60 and col. 4 line 21 through col. 5 line 15).

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Regarding claim 15, Liao teaches a non-volatile memory (754, figure 7B) for storing the second identifier (col. 13 lines 64-66).

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Regarding claim 17, England discloses a network comprising a first client computer (14, figure 1), and a transmission medium coupled to the first client computer (col. 2 lines 53-63 and col. 3 line 51 through col. 4 line 20). England differs from the claimed invention in not specifically teaching a server computer coupled to the first client computer that transmits first identification data to the first client computer upon receiving a request from the client computer to certify a first software-defined radio implemented at the first client computer. However, Liao teaches a technique for ensuring secure access to local service of a communication device of a wireless communication system comprising a network gateway (104, figure 1) coupled to the transmission medium (106, figure 1) that transmits a message including a first identification data to a communication device upon receiving a request to certify a first software-defined radio implement at the communication device (figure 3 and col. 6 line 36 through col. 7 line 54). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify England in having the server computer coupled to the first client computer that transmits first identification data to the first client computer upon receiving a request from the client computer to certify a first software-defined radio implemented at the first client computer, as per teaching of Liao, in order to ensure secure access to local service of the communication device.

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Regarding claim 18, Liao teaches a second communication device coupled to the transmission medium so that the network gateway transmits the first ID data to the second communication device upon receiving a request from the second communication device to certify the first software-defined radio implemented at the second communication device (col. 4 lines 38-45).

Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 21, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claim 22, the limitations of the claim are rejected as the same reasons set forth in claim 18.

Regarding claim 23, the limitations of the claim are rejected as the same reasons set forth in claim 7.

8. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over England et al. (US PAT. 5,511,069 hereinafter England) in view of Liao et al. (US PAT. 6,292,833 hereinafter Liao) as applied in claim 1 above, and further in view of Paulsen et al. (US PAT. 6,055,575 hereinafter Paulsen).

Regarding claims 5-6, the combination of England and Liao differs from the claimed invention in not specifically teaching the first identifier and the wireless protocol being received

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as a component of a signed manifest so that the protocol at the baseband unit is executed if the manifest is validated. However, Paulsen teaches a virtual private network method for remote user to access a private network having a host to combine data with a header containing information about the protocol of the private data network, to encrypt the data and the header as a component of a signed manifest, and to transmit the encrypted data and the header over a secure communications path to the remote client, wherein the protocol is executed if the manifest is authenticated (col. 5 line 55 through col. 8 line 41). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of England and Liao in receiving the first identifier and the wireless protocol as the component of the signed manifest so that the protocol at the baseband unit is executed if the manifest is validated, as per teaching of Paulsen, in order to establish a secure communication in permitting an individual to access the private data network.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu et al. (US PAT. 6,587,684) discloses a digital wireless telephone system for downloading software to a digital telephone using wireless data link protocol (abstract). Naslund (US PAT. 5,557,676) discloses a system for authentication the identification of mobile stations during system access (abstract). Obayashi et al. (EP 0650307A2) discloses a radio telecommunication apparatus for storing at least one authentication number corresponding to at least one system identification number in order to make user friendly (col. 2 line 25 through col.

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3 line 2). Daniel et al. (FR 2680059A1) discloses a method for managing calls in a broadcast-type radiotelephony network (abstract).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George Eng
Primary Examiner
Art Unit 2643